UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,010	11/17/2003	David S. Benco	LUTZ 2 00251	3279

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EXAMINER
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ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/715,010	BENCO ET AL.
	Examiner	**Art Unit**	
	Aung T. Win	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 April 2006</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>*1-15*</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>*1-15*</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 04/05/2006 have been fully considered but they are

not persuasive.

Applicants argue that Qua expressly teaches away from the teaching of Bartfeld.

To support this argument, applicants rely on the "background of the invention" section of

Qua, which states, as disclosed by Applicants, "such communication techniques are

ineffective because, in order to gain full advantage of the portable/wireless devices, they

are being used in non-traditional environments outside the home or office." On the

other hand, applicants added, Bartfeld can only be used where the user has subscribed

to a television service.

Examiner respectfully disagrees with Applicants' assertions by reminding

Applicants that the prior art's mere disclosure of more than one alternative does not

constitute a teaching away from any of these alternatives because such disclosure does

not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391

F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). In addition, nowhere in the

Qua's reference there is any direct or indirect criticism of the solution claimed in the

Bartfeld reference. Moreover, Qua's invention is to provide the method of recording

specific conversion and further to store in a network storage device in which the system

is implemented to interface with **other communications systems** including voice

servers [See Summary]. Therefore, Examiner asserts that there is no teaching away

present in the rejection as written. And, the rejection, as written, stands.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Qua discloses a system recording specific conversation based on user command and further storing the recorded conversation in a network storage device. Bartfeld also teaches a system recording the phone conversation based on the user command further storing the recorded conversation in a network storage device i.e., voice mail server. Qua also teaches that the system provides an interface with other communications systems including voice servers. Therefore, the references are the analogous arts and the rejection, as written, stands.

Applicant also argues that Qua does not expressly disclose that the system monitors the reverse link and detects the signals transmitted on the reverse link. Examiner disagrees. Qua teaches that the system records and stores specific conversation in a network storage device based on the detected the user record commands. Therefore, it is obvious to one of ordinary skill in the art at the time of invention of made that Qua's method teaches claimed monitoring step because the

system is monitoring the reverse link by determining whether the user record command

signal is detected from the user i.e., revere link.

Applicant also argues that Qua does not teach the opening of a connection

between the mobile station and a voice mailbox messaging system based on the first

code. Modified system clearly teaches such limitation in order to store the recorded

conversion in the voicemail server.

In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., voice **mailbox** messaging system) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993).

Cited limitation in rejected claim is voice messaging system. Not all the voice

messaging system is voice **mailbox** messaging system. At the time of invention of

made, it is obvious to one of one of ordinary skill in the art the voice messaging system

is the system to store and retrieve recorded or stored audio messages. The examiner is

fully aware of what the claims do not call for, as well as what they do require. During

patent examination, the claims are given the broadest reasonable interpretation

consistent with the specification. See In re Morris, 127 F.3d 1048, 44 USPQ2d 1023

(Fed. Cir. 1997). See MPEP § 2111 - § 2116.01 for case law pertinent to claim

analysis.

Applicant also contends that modified system does not teach validating the

mobile station i.e., validating the mobile station by **determining if the user is a**

subscriber. Such determination limitation is not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993). At the time of invention of made, it is also obvious to

one of ordinary skill in the art that Qua's system provide services to users with mobile

station registered with the network and therefore Qua's method comprises claimed

validating step to determine if the user is authorized access to the network.

Applicant also argues that modified system does not disclose voice memo control

module, a first or second communication path or a voice handler. At the time of

invention of made, it is obvious to one of ordinary skill in the art that modified message

recording and retrieving system comprises claimed components because such

components are implemented and utilized in applications such as retrieving messages.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the

> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Qua et al. (US Patent Number: US006222909B1) in view of Bartfeld et al. (US

Publication Number: US 20030086432A1).

Regarding Claim 1, Qua discloses a method for supporting a network-based

audio note-taking feature (reads on network-based voice memo feature) [Summary]

[Figure 1] for wired and wireless terminal user devices in telecommunication network

[Column 2, Line 49- Column 3, Line 7]. Qua's method comprises:

Recording a specific conversation during a conversation between users [Column 1, Line

40-49] [Column 3, Line 22-39] [Column 4, Line 29-39] or retrieving a recorded

conversation i.e., retrieving recorded notes during the current call [Column 6, Line 39-

44] (Recording or retrieving step reads on maintaining step).

One skilled in the telecommunications art would realize that the voice call in Qua's

method have a forward link and reverse link in which reverse link being a link from a

mobile station to a base station since the method is operative to the telecommunication

network as depicted in Figure 1.

Qua teaches monitoring and detecting control signals (i.e., record signal and terminate

signals) generated by mobile stations on reverse links (see reverse link as stated

above) (Also See [Column 3, Line 22-26] [Column 5, Line 28-31] [Column 6, Line 59-

Column 7, Line 30] for generating control signals by users for recording audio notes and

retrieving recorded audio notes i.e., initiating recording sequence (pressing start button)

or terminating recording sequence (pressing stop button) or retrieving recorded audio

notes sequence. (Generating a start sequence reads on a first code and generating a

stop sequence reads on a second code).

Although Qua's method store the recorded voice data in network based storage 180,

Qua fails to teach the opening a connection step between the mobile station and a voice

messaging system based on the first code then record to store voice data in a voice

mailbox based on the first code.   Instead, Qua's method teaches a recording step to

store the recorded voice data in Network Storage 180 Storage 180 [Figure 1] [Column

3, Line 59-66] based on a first code and further discloses a distribution step option in

which recorded voice data stored in Network to be forwarded to a voice mail server

[Step 310, Step 320, Step 322 and Step 324 in Column 5, Line 48-Column 6, Line 4]

using voice mail addresses (reads on identification of voice mail boxes) based on a

distribution code.

Bartfeld teaches a telephone call management system and method in which a

telephone conversation can be recorded in the voice mail server 90 [Figure 1, 2 & 3]

[Step 870 in Figure 7] [Column 5, Paragraph 0044] based on record command

[Paragraph 0044, Line 9-10].   Bartfeld's system and method also teaches the storing of

voice data in other recording devices for extreme flexibility [Column 5, Paragraph 0045,

Line 9-13].

Therefore, it would have been obvious to one of ordinary skill in the art to modify the

Qua's voice recording and storing method with Bartfeld's method to record a voice data

using voice messaging system based on a first code by efficiently removing network

storage and utilizing existing voice messaging system to store recorded data. One of

ordinary skill in the art would have been motivated to do this to reduce the processing

step and to implement cost-effective system by reducing the hardware expenditures.

Claim 6 is an apparatus claim rejected for the same reasons as stated above in

Claim 1 rejections because claim means read on corresponding method steps rejected

in Claim 1. Modified Qua's system for network-based voice memo would have

corresponding means for executing the claims' step recited in Claim 1 rejection.

Claim 11 is rejected for the same reasons as stated above in claim 1 rejection

because Claim means substantially read on corresponding method steps rejected in

Claim 1. Modified Qua's system has a voice messaging system 170 [Figure 1 of Qua].

One skilled in the telecommunications art would also realize that there would be a

switching component implemented and operative to maintain a voice call in the modified

Qua's system in order to provide the network-based voice memo feature. Qua clearly

teaches the requirements and implementation of switches necessary to perform such

network features in the telecommunication network [Qua reference: Column 2, Line 55-

60 & Column 3, Line 8-21] [Also see Bartfeld reference: Telephony switch 25 in Figure

1-3 & Column 3, Paragraph 0029, Line 7-20]. Modified Qua's system comprises a

control module [See Qua reference: Column 3, Line 8-26] i.e., a controller implemented

in note taking mechanism 129 reads on a control module.

Regarding Claims 2, 7 & 12, note taking mechanism 129 verify if the user has

enabled a private mode function (reads on validating the mobile station) [See Qua

reference: Column 4, Line 60-62].

Regarding Claims 3, 4, 8, 9, 13 & 14, modified Qua's system identification step to

identify the stored information in order to retrieve the stored information correctly from

stored voice mail addresses i.e., voice mail box [See Qua reference: Column 3, Line 65;

Column 5, Line 18-41 & Column 6, Line 33-35]. One skilled in the telecommunication

arts also would realize that stored recorded voice data would have been identified and

store in a voice mailbox in order to retrieve the targeted message in modified Qua's

system. Moreover, Identifying the voice message for storing in a voice mailbox and for

retrieving the identified voice message is well known to one of skilled in the

telecommunication arts.

Regarding Claims 5, 10 & 15, modified Qua's system would have connected the

mobile station and the voice messaging system through the voice memo control module

i.e., the controller implemented in note taking mechanism [See the claim 11 rejection]

and a voice handler i.e., the audio recording processors implemented in note taking

mechanism in order to record the conversation i.e., voice memo (a first path reads on

the communication path from a mobile station to the controller of note taking

mechanism for the controller to receive the control signals i.e., first code and second

code) and (a second path reads on the communication path between the controller of

note taking mechanism and the corresponding processors).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

| Beith et al. | US Publication Number: | US 20030235275A1 |
| Moores et al. | US Publication Number: | US 20040132432A1 |

Silberfenig et al.	US Publication Number:	US20010041590A1
Schuster et al.	US Patent Number:	US006795429B1
Sahasrabudhe	US Publication Number:	US 20030210768A1

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aung T. Win whose telephone number is (571) 272-7549. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aung T. Win
Group Art Unit 2617
June 14, 2006

DUC NGUYEN
PRIMARY EXAMINER